

### **REMARKS**

The October 11, 2007 Final Office Action was based on pending Claims 33–45, 48–54 and 56–66. No claims are being amended or canceled by this Response. In view of the remarks set forth below, Applicant respectfully requests reconsideration of Claims 33–45, 48–54 and 56–66 and submits that Claims 33–45, 48–54 and 56–66 are in condition for allowance.

### **SUMMARY OF REJECTIONS**

The Final Office Action rejects Claims 33–36, 38 and 41 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,865,680 to Briggs ("Briggs") in further view of U.S. Patent No. 6,426,741 to Goldsmith et al. ("Goldsmith").

Claims 37, 39, 40, 42–45, 48–54 and 56–66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Briggs and Goldsmith and in further view of U.S. Patent No. 5,114,155 to Tillery et al. ("Tillery") and U.S. Patent No. 6,371,375 to Ackley et al. ("Ackley").

### **REQUEST FOR SUSPENSION OF ACTION**

Submitted concurrently herewith is a Request for Suspension of Action under 37 C.F.R. § 1.103(c) for a period of three months.

### **CANCELED CLAIMS 46, 47 AND 55**

The body of the Final Office Action indicates that Claims 46, 47 and 55 are pending and are rejected in view of the cited art. Applicant respectfully notes that these claims were canceled in Applicant's Amendment filed June 22, 2007. Applicant, therefore, respectfully requests appropriate correction in any subsequent action by the Patent Office.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)**

The Final Office Action rejects Claims 33–36, 38 and 41 as being unpatentable over Briggs in further view of Goldsmith. Claims 37, 39, 40, 42–45, 48–54 and 56–66 were rejected as being unpatentable over Briggs and Goldsmith and in further view of Tillery et al. and Ackley. As discussed below, Applicant respectfully traverses these rejections and respectfully requests reconsideration of the pending claims.

**Independent Claim 33**

Focusing on independent Claim 33, in one embodiment of Applicant's invention, an interactive gaming system is disclosed for entertaining one or more play participants. The system comprises, among other things, one or more play modules disposed within a play structure. Each play module includes multiple play elements comprising one or more interactive games or challenges to be played/completed by the play participant(s) as part of an overall quest or mission. At least two of the interactive games or challenges are arranged or organized sequentially such that a first interactive game or challenge is necessary to be played or completed before a second game or challenge can be played or completed.

The system further comprises at least one portable indicium associated with and uniquely identifying each play participant, the portable indicium including a toy wand operable by play participants by waving, shaking, stroking and/or tapping the wand in a predetermined manner to wirelessly actuate at least one of the play elements.

The Final Office Action asserts that Briggs teaches all the elements of independent Claim 33 except that "Briggs lacks explicitly disclosing that the game theme is a wizardry/fairy type theme where the use of a portable indicium such as a wand as a play element is involve[d]." The Final Office Action then combines Briggs with Goldsmith, which discloses an input device 10 (i.e., a wand) for wirelessly controlling a computer presentation of video signals (see, e.g., column 1, lines 38–40). The motivation given for this combination is that "[Briggs] states that other game themes could be implemented" (see page 3 of Final Office Action).

Applicant respectfully submits that it would not have been obvious to a skilled artisan at the time of Applicant's invention to combine Briggs and Goldsmith to teach the interactive gaming system of independent Claim 33. For instance, there appears to be no suggestion or motivation to use the input device 10 of Goldsmith to wirelessly actuate play elements in a play structure, such as the kinetic play elements in the play structure described in Briggs. Moreover, Applicant was unable to find any suggestion from Briggs for wirelessly activating kinetic play elements with a portable device.

The Supreme Court recently explained that "a patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_, \_\_\_, 82 U.S.P.Q.2d 1385, 1396 (2007). Moreover, "[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006).

Moreover, it is also not sufficient for the Final Office Action to apply hindsight to piece together prior art to show the teaching of Applicant's invention. It is not permissible to reconstruct the patentee's claimed invention from the prior art by using the patentee's claim as a "blueprint." When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985); See also M.P.E.P. § 2145(X)(A).

Furthermore, Applicant submits that even if Briggs and Goldsmith are combined, they do not teach or suggest every element of independent Claim 33. For example, the Final Office Action appears to cite Goldsmith's wand 10 as being one of the claimed "play elements operatively associated with each . . . play module." The Final Office Action, however, does not explain how Briggs or Goldsmith teaches or suggests the claimed "at least one portable indicium associated with and uniquely identifying each play participant" as recited by independent Claim 33. Moreover, the Final Office Action does not explain how, if Goldsmith's wand is equivalent to a "play element," what "portable indicium [is] operable by play participants by waving, shaking, stroking and/or tapping said wand in a predetermined manner to wirelessly actuate at least one of said multiple play elements," as recited by independent Claim 33.

Because the references cited by the Office Action are not properly combinable and, even if combined, do not disclose, teach or suggest the interactive gaming system of amended independent Claim 33, Applicant asserts that Claim 33 is patentably

distinguished over the cited art, and Applicant respectfully requests allowance of Claim 33.

**Independent Claim 42**

Amended independent Claim 42 is believed to be patentably distinguished over the cited art for reasons similar to those set forth above with respect to the patentability of independent Claim 33 and for the different aspects recited therein.

**Independent Claim 52**

Amended independent Claim 52 is believed to be patentably distinguished over the cited art for reasons similar to those set forth above with respect to the patentability of independent Claim 33 and for the different aspects recited therein. Moreover, neither Briggs, Goldsmith, Tillary, Ackley, nor a combination thereof, teaches or suggests "allowing . . . one or more recognized play participants to play with a second group of play elements operatively associated with [a] second play environment to achieve a second set of desired goals, points or game levels, wherein [a] portable toy device is configured to wirelessly actuate at least one play element of said second group of play elements," as recited in independent Claim 52.

**Independent Claim 59**

Amended independent Claim 59 is believed to be patentably distinguished over the cited art for reasons similar to those set forth above with respect to the patentability of independent Claim 33 and for the different aspects recited therein.

**Dependent Claims**

Claims 34–41 depend from independent Claim 33 and are believed to be patentably distinguished over the cited art for the reasons set forth above with respect to Claim 33 and for the additional features recited therein.

Claims 43–45 and 48–51 depend from independent Claim 42 and are believed to be patentably distinguished over the cited art for the reasons set forth above with respect to Claim 42 and for the additional features recited therein.

Claims 53, 54 and 56–58 depend from independent Claim 52 and are believed to be patentably distinguished over the cited art for the reasons set forth above with respect to Claim 52 and for the additional features recited therein.

Claims 60–66 depend from independent Claim 59 and are believed to be patentably distinguished over the cited art for the reasons set forth above with respect to Claim 59 and for the additional features recited therein.

#### **PRIORITY OF PRESENT APPLICATION**

Applicant also notes that the filing date of Goldsmith (*i.e.*, September 30, 1999) is after the earliest claimed priority dates of the present application. In particular, the present application claims the benefit of U.S. Provisional Application Nos. 60/128,318 filed April 8, 1999, and 60/122,137 filed February 26, 1999. Thus, Applicant reserves the right in any future paper to present arguments that Goldsmith is not prior art.

#### **NO DISCLAIMERS OR DISAVOWALS**

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

#### **CONCLUSION**

In view of the foregoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain, the Examiner is cordially invited to contact the undersigned such that any remaining issues may be promptly resolved.

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Moreover, by the foregoing remarks no admission is made that any of the above-cited references are prior art to the pending claims and/or are properly combinable. Furthermore, Applicant respectfully disagrees with the Examiner's characterization of the cited references and reserves the right to distinguish the substantive content of these references in response to any subsequent Office Action.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: 10/29/2007

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